FILE COPY

Office-Supreme Court, U.S.
FILED
APR 22 1960
JOHN T. BROWNING, Clerk

No. 826

In the Supreme Court of the United States

OCTOBER TERM, 1959

COMMISSARIAT A L'ENERGIE ATOMIQUE, Assignee of Patent Applications of JEAN HENRI HALBAN, JEAN FREDERIC JOLIOT and LEW KOWARSKI, PETITIONER

v.

ROBERT C. WATSON, Commissioner of Patents

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

J. LEE RANKIN,
Solicitor General,

GEORGE COCHRAN DOUB,
Assistant Attorney General,

MORTON HOLLANDER,
JOHN G. LAUGHLIN, JR.,
Attorneys,
Department of Justice,
Washington 25, D. C.

INDEX

	Page
Opinions below	1
Jurisdiction	1
Question presented	2
Statutes involved	2
Statement	4
Argument	6
Conclusion	10

CITATIONS

Cases:

Barr v. *United States*, 324 U.S. 83	7
Campbell v. *Commissioner of Patents*, No. 300, October Term, 1954, certiorari denied, 348 U.S. 858	9
Commissariat a L'Energie Atomique v. *Robert C. Watson, Commissioner of Patents*, 274 F. 2d 594	5
Dalton & Cooley v. *Marzall*, No. 87, October Term, 1951, certiorari denied, 342 U.S. 818	9
Ducci v. *Commissioner of Patents*, No. 603, October Term, 1955, certiorari denied, 350 U.S. 982	9
Hoover Co. v. *Coe*, 325 U.S. 79	9
McBride v. *Teeple*, 311 U.S. 649	7
Martin v. *Commissioner of Patents*, No. 130, October Term, 1952, certiorari denied, 344 U.S. 824	9
Pacific Northwest Canning Co. v. *Skookum Packers' Assn.*, 283 U.S. 858	7
Postum Cereal Co. v. *California Fig Nut Co.*, 272 U.S. 693	6, 7, 8
Rubenfield v. *Robert C. Watson, Commissioner of Patents*, No. 622, October Term, 1959, certiorari denied, February 29, 1960	9
Shackell v. *Marzall*, No. 763, October Term, 1951, certiorari denied, 343 U.S. 978	9
Special Equipment Co. v. *Coe*, 324 U.S. 370	9

Cases—Continued Page

Tatincloux v. *Commissioner of Patents*, No. 734, October Term, 1955, certiorari denied, 351 U.S. 907 9

Thompson v. *Learned*, No. 496, October Term, 1951, certiorari denied, 342 U.S. 942 9

Statutes:

Act of August 22, 1914, 38 Stat. 703 7

Act of March 2, 1929, c. 488, Sections 1-4, 45 Stat. 1475 7

Act of June 25, 1948, 62 Stat. 683 ..... 7, 8

Judicial Code, Section 195, 36 Stat. 1145, as amended 7, 8

P.L. 85-755, 72 Stat. 848 8

R.S. 4888 4

Tariff Act of 1930, 46 Stat. 590, Section 647 7

28 U.S.C. 211 ..... 2, 8

28 U.S.C. (1946 ed.) 308 7

28 U.S.C. 1541 8

28 U.S.C. 1254 9

28 U.S.C. 1256 ..... 2, 7, 8, 9

35 U.S.C. 112 ..... 3, 4

35 U.S.C. 133 5

35 U.S.C. 145 ..... 3, 5

Miscellaneous:

H. Rept. No. 2349, 85th Cong., 2d Sess. 8

S. Rept. No. 2309, 85th Cong., 2d Sess. 8

Stern and Gressman, *Supreme Court Practice* (2d ed., 1954), pp. 47-50 8

In the Supreme Court of the United States

OCTOBER TERM, 1959

No. 826

COMMISSARIAT A L'ENERGIE ATOMIQUE, Assignee of Patent Applications of JEAN HENRI HALBAN, JEAN FRÉDERIC JOLIOT and LEW KOWARSKI, PETITIONER

v.

ROBERT C. WATSON, Commissioner of Patents

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinions of the United States Court of Customs and Patent Appeals (Pet. App. 1a-11a) are reported at 270 F. 2d 954.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 20, 1959 (Pet. App. 8a). A petition for a rehearing, timely filed, was denied

on October 30, 1959. On January 28, 1960, the time in which to file a petition for a writ of certiorari was extended to and including March 28, 1960. The petition for a writ of certiorari was filed on March 28, 1960. The petitioner attempts to invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTION PRESENTED

Whether this Court has jurisdiction to review a decision by the United States Court of Customs and Patent Appeals, which affirmed the refusal of the Board of Appeals of the United States Patent Office to grant an application for a patent.

STATUTES INVOLVED

28 U.S.C. 1256 provides:

> *Court of Customs and Patent Appeals; certiorari.*
>
> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

28 U.S.C. 211 provides:

> *Appointment and number of judges.*
>
> The President shall appoint, by and with the advice and consent of the Senate, a chief judge and four associate judges who shall constitute a court of record known as the United States Court of Customs and Patent Appeals. Such court is hereby declared to be a court established under Article III of the Constitution of the United States.

35 U.S.C. 112 provides:

Specification.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. 145 provides:

Civil action to obtain patent.

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his

invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

STATEMENT

The petitioner seeks review of the denial of an application for a patent filed with the Commissioner of Patents. The application relates to "Improvements in and Relating to the Production of Energy through Nuclear Fission" (Pet. App. 1a). The petitioner's claims were rejected by the Commissioner and the Board of Appeals of the United States Patent Office primarily on the ground that the specification required by 35 U.S.C. 112 *(supra,* p. 3) was not satisfied in that the petitioner's claims are insufficient to enable those skilled in the art to make and use the invention (Pet. App. 4a). As a means of showing the operability and patentability of its invention, the petitioner, before the Court of Customs and Patent Appeals, sought to rely upon disclosures in two previous patent applications (Pet. App. 4a). The two previous patent applications, prosecuted by the petitioner's predecessor in title, the Alien Property Custodian (Pet. App. 6a-7a), had been rejected on the ground that they too did not contain disclosures sufficient to meet the requirements of R.S. 4888 (now 35 U.S.C. 112) and those rejections were affirmed by the Board of Appeals (Pet. App. 3a-4a). No appeal

to the court below was taken from those determinations and the petitioner's suit in the district court under 35 U.S.C. 145, *supra*, p. 3, for a determination of the merits of its prior patent applications was not timely commenced (Pet. App. 4a; 15a).[1] Because of final and binding adjudications as to the insufficiencies of the prior applications, the court below held that the prior disclosures could not be used to introduce an operative disclosure in the application then before it (Pet. App. 5a). Independent of the prior disclosures, the court held that the petitioner's specification "is entirely devoid of any recitation of methods or means of making the alleged invention operable" (Pet. App. 7a). Accordingly, because the petitioner's application "does not comply with the provisions of 35 U.S.C. 112" (Pet. App. 7a), the decision of the Board of Appeals was affirmed on July 20, 1959. The petitioner's timely motion for a rehearing was denied on October 30, 1959 (Pet. 9). Following the decision by the Court of Appeals, the petitioner sought leave to file a petition for rehearing out of time. This request was rejected by the court below on March 8, 1960 (Pet. 9-10).

---

[1] On January 21, 1960, the Court of Appeals for the District of Columbia Circuit, reversing in part the judgment of the district court, held that the district court had jurisdiction to review, for arbitrariness or capriciousness, a decision of the Commissioner of Patents refusing, under 35 U.S.C. 133, to revive the two prior patent applications. The Court of Appeals and the district court were, however, in agreement that the district court, under 35 U.S.C. 145 (*supra*, p. 3), was without jurisdiction to consider the merits of the prior patent applications (Pet. App. 12a-18a; *Commissariat a L'Energie Atomique* v. *Robert C. Watson, Commissioner of Patents*, 274 F. 2d 594).

ARGUMENT

The question of whether the petitioner's application to the Patent Office disclosed a patentable invention is essentially one of fact and within the peculiar expertise of the court below. We submit that the decision below is correct and does not involve a question warranting review by this Court.[2] The petition should, however, be denied on jurisdictional grounds.

In *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693, the Court held that decisions of the Court of Appeals of the District of Columbia on appeal from decisions of the Patent Office in patent and trademark applications were not reviewable by this Court because such a decision is not a judicial judgment but is "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. 698-699. Hence, such a decision was not a justiciable case or controversy and was beyond the constitutional power of this Court to review.

---

[2] In view of the limited scope of the decision of the Court of Appeals for the District of Columbia on January 21, 1960 (*supra*, n. 1, p. 5), the court below did not abuse its discretion in denying the petitioner leave to file, out of time, a petition for rehearing based upon the decision of the Court of Appeals. Similarly, there was no impropriety in the court below taking notice of the fact that the two prior patent applications, relied upon by the petitioner, had been rejected for insufficient disclosures. In any event, these questions clearly are not of such importance as to warrant review by this Court.

The jurisdiction of the Court of Appeals for the District of Columbia over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1-4, 45 Stat. 1475. But the nature of the proceeding was not changed, and thereafter, in denying certiorari in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction" and cited the *Postum Cereal* case.

In the present proceeding, the petitioner invokes 28 U.S.C. 1256, *supra*, p. 2, to sustain the Court's jurisdiction (Pet. 2). Section 1256 is part of the Act of June 25, 1948, 62 Stat. 683, codifying Title 28 of the United States Code. Prior to that codification, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was a provision relating to customs cases.[3] That provision was Section 195 of the old Judicial Code as amended.[4] Section 195 comprised

---

[3] Summary appeals from the decisions of the Board of Appeals of the Patent Office to the Court of Customs and Patent Appeals in patent matters are to be distinguished from appeals taken to the Court of Customs and Patent Appeals from judgments of the United States Customs Court. Clearly, the latter are judicial in character and are reviewable by this Court. See, *e.g.*, *Barr* v. *United States*, 324 U.S. 83.

[4] Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

two elements, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases, and a second authorizing this Court to review such decisions. It did not refer to patent or trademark matters. The codification of Title 28 merely separated the foregoing two provisions, placing the former in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256.[5] Nothing in the codifying Act of 1948 or in its history suggests that Congress had any intention of giving this Court the power to review a class of cases over which jurisdiction had previously been withheld or to supersede the holding in the *Postum Cereal* case.[6] Stern and Gressman, *Supreme Court Practice* (2d ed., 1954), pp. 47-50. And since the enactment into positive law of Title 28, United States Code, this Court has denied certiorari in at least the following cases where the petitioners, in patent and trademark matters, invoked Section

---

[5] The Reviser's Notes to Sections 1256 and 1541 confirm this derivation of those provisions.

[6] The same is true of the 1958 amendment to 28 U.S.C. 211 (*supra*, p. 2), P.L. 85-755, 72 Stat. 848, relied upon by petitioner (Pet. 11-12), which obviously does not remedy the jurisdictional defect inherent in this case:

> [T]he purpose and effect of the bill [H.R. 7866], as amended, is to integrate the Court of Customs and Patent Appeals into the constitutional system of Federal courts and to make its judges, both active and retired, available for assignment when and as their services are needed to meet congested calendars in other courts just as has already been done in the case of the Court of Claims and the Customs Court. [S. Rept. No. 2309, 85th Cong., 2d Sess., p. 5; see also, H. Rept. No. 2349, 85th Cong., 2d Sess.]

1256 as the jurisdictional authority of the Court and where the respondent's brief in opposition urged a lack of jurisdiction:[7] *Campbell* v. *Commissioner of Patents*, No. 300, October Term, 1954, certiorari denied, 348 U.S. 858; *Martin* v. *Commissioner of Patents*, No. 130, October Term, 1952; certiorari denied, 344 U.S. 824; *Shackell* v. *Marzall*, No. 763, October Term, 1951, certiorari denied, 343 U.S. 978; *Thompson* v. *Learned*, No. 496, October Term, 1951, certiorari denied, 342 U.S. 942; *Dalton & Cooley* v. *Marzall*, No. 87, October Term, 1951, certiorari denied, 342 U.S. 818; *Ducci* v. *Commissioner of Patents*, No. 603, October Term, 1955, certiorari denied, 350 U.S. 982; *Tatincloux* v. *Commissioner of Patents*, No. 734, October Term, 1955, certiorari denied, 351 U.S. 907; *Rubenfield* v. *Robert C. Watson, Commissioner of Patents*, No. 622, October Term, 1959, certiorari denied, February 29, 1960.

---

[7] The jurisdiction exercised by the Court in *Hoover Co.* v. *Coe*, 325 U.S. 79, and *Special Equipment Co.* v. *Coe*, 324 U.S. 370, involved certiorari to the Courts of Appeals under 28 U.S.C. 1254. Those cases have no application here. Cf. Pet. 11.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied on jurisdictional grounds.

Respectfully submitted,

J. LEE RANKIN,
Solicitor General.

GEORGE COCHRAN DOUB,
Assistant Attorney General.

MORTON HOLLANDER,
JOHN G. LAUGHLIN, JR.,
Attorneys.

APRIL 1960.

☆ U. S. GOVERNMENT PRINTING OFFICE: 1960 547302 1348